IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF

Applicant: Michael J Witz et al.

Title: COMMUNITY BASED FINANCIAL PRODUCT

Docket No.: 2043.197US1
Filed: June 21, 2000
Examiner: Daniel Kesack

Serial No.: 09/599,051
Due Date: January 30, 2007
Group Art Unit: 3624

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

X Appeal Brief Under 37 CFR 41.37 (16 pgs.) including authorization to charge Deposit Account 19-0743 in the amount of $500.00 to cover the Appeal Fee.
X Return postcard.

If not provided for in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Customer Number 49845

By: /Joseph P. Mehrle/
Atty: Joseph P. Mehrle
Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of January, 2007.

Name Peter Rebuffoni

Signature

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Michael J. Witz et al.	Examiner: Daniel Kesack
Serial No.: 09/599,051	Group Art Unit: 3624
Filed: June 21, 2000	Docket: 2043.197US1

Title: COMMUNITY BASED FINANCIAL PRODUCT

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on December 28, 2006 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on November 30, 2006, from the Final Rejection of claims 1-12 of the above-identified application, as set forth in the Final Office Action mailed on October 6, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

TABLE OF CONTENTS

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, EBAY INC.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on June 21, 2000 with claims 1-21. A non-final Office Action mailed March 24, 2006. A Final Office Action (hereinafter "the Final Office Action") was mailed September 25, 2006. Claims 1-12 stand twice rejected, remain pending, and are the subject of the present Appeal. Claims 13-21 were previously withdrawn.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated September 25, 2006.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, systems and methods of fabrication

Independent Claim 1

1. A machine-implemented method comprising (*FIG. 2*) :

receiving over a wide-area network (WAN) an indication of a preference of a user (*FIG. 2, reference numeral 200; specification page 6 first full paragraph)* from a first population of users that form a virtual community (*Specification page 3 first and second paragraphs*), wherein the first population of users is identified as investment analysts (*Specification page 3 second full paragraph*), and wherein the preference from the user is a selection of an investment or an allocation for the investment that the user provides to the virtual community (*Specification page 4 first full paragraph*);

aggregating the preference into a database of previously received preferences from the first population, the aggregation being a set of preferences (*Specification page 4 first, second, and third paragraphs; page 7 last paragraph; and original filed claim 1*); and

deriving a financial product for a second population of users in response to the set of preferences, the second population of users identified as investors (*Specification page 6 second paragraph and page 8 fist full paragraph*).

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and its legal equivalents for a complete statement of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

§102 Rejection of the Claims

Claims 1-3 were rejected under 35 U.S.C. § 102(e) for anticipation by Reese (U.S. 6,236,980) (hereinafter Reese).

§103 Rejection of the Claims

Claims 8-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claims 1 and 2 above, and further in view of Segal et al. (U.S. 6,049,783) (hereinafter Segal).

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claim 1 above, and further in view of Phillips et al. (U.S. 6,473,084) (hereinafter Phillips).

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese as applied to claims 1 and 2 above, and further in view of Wallman (U.S. 6,338,047) (hereinafter Wallman).

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §102(e).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P § 2131.* To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

B) Discussion of the rejections for claims 1-3 under 35 U.S.C. § 102(e) as being anticipated by Reese.

Claims 1-3 were rejected under 35 USC § 102(e) as being anticipated by Reese. This rejection is respectfully traversed, Appellant respectfully submits that the Final Office Action has made an improper prima facie showing of anticipation at least because Reese fails to teach the identical invention in as complete detail as is recited in independent claim 1 with respect to the following: "a virtual community," "preference from the user is a selection of an investment or an allocation for the investment that the user provides to the virtual community," and "deriving a financial product." Each of these will be addressed in turn.

The Reese reference fails to teach or suggest a "virtual community" that is capable of performing or being used in the manners that are positively recited in Appellant's independent claim 1. More specifically, Reese is directed to an investment knowledge system that makes investment decisions for users by mining investment sources and pushing investment recommendations to the users. See, Reese Fig. 1 reference numeral 100 (user's pick a recommendation source); also see, Reese Fig.'s 7 and 14 (recommendations picked for the user; the user does not make recommendations at all in Reese); also see, Reese, column 11 lines 52-

55, and the entire discussion of Reese where there is no indication whatsoever that the user makes a recommendation or provides an investment selection to a "virtual community."

The phrase "virtual community" includes a specific recognized meaning in the industry; and that meaning, Appellant believes, the Examiner has completely ignored in the rejections of record. The Board's attention is directed to www.wikipedia.org keyword for search of "virtual community." Here, an industry standard definition includes an explanation of "virtual community" in which a "group of people interact via the Internet." The Reese reference is not a group of anything interacting over the Internet. It is a service that is provided to individuals. The individuals do not interact with one another. Reese summarizes and pre-picks investment sources (articles). The articles are scanned and mined and decisions about investment recommendations are pushed to subscribing users. This scenario described throughout Reese is not a virtual community at all, it is a traditional service made available to users. The users do not cooperate or interact with one another in the Reese teaching at all.

Additionally, Reese describes users of its system as individuals that subscribe and get pushed recommendations that are mined from investment sources. A recommender is an "author" of a particular recommendation source (magazine or investment publication). See Reese, column 6 lines 27-36. There is no ability at all in Reese where the user can make a selection for an investment or an allocation of an investment and provide that to the virtual community. See Reese, column 2 lines 51-54 for passive nature of the Reese user. Clearly, a recommender in Reese is not a user and the recommender does not interact in a community; the recommender is just an author of a publication that is being scanned and mined in an automated fashion by Reese. See, Reese, column 12 lines 26-33 (Reese predetermines investment sources and scans them to make recommendations). There is no teaching or any ability whatsoever in Reese where the "preference from a user" is a "selection of an investment or an allocation for the investment that the user provides to the virtual community."

Also, Reese does not permit "deriving a financial product." Reese includes no teaching or ability where a financial product is derived. All the financial products in Reese pre-exist and are mined from existing investment articles. There is not a single financial product that is derived in Reese. A user in Reese manually evaluates a summary of investment sources and recommendations and makes his/her decision.

Appellant respectfully asserts that the Examiner has tried to pigeonhole the teachings of Reese into the teachings of independent claim 1 but this cannot be done because fundamentally Reese is not about and does not teach a "virtual community" associated with investments where "users" make selections for "investments" to the "virtual community." Reese is entirely something different; it scans already written investment articles from what it terms authors who are recommenders and summarizes that information and pushes recommendations to a subscribing user. Users do not interact in a community and are not capable of supplying investment selections to one another. These are core differences, which at the very least demonstrate that Reese fails to teach the "identical invention" in as "complete detail as the claims," which is required by the law of anticipation.

Accordingly, Appellant respectfully requests that the rejections of record be withdrawn and that the claims be allowed.

C) Discussion of the rejections for claims 4-12 under 35 U.S.C. § 103(a) as being unpatentable over Reese and in view of various combinations of Segal, Phillips, and Wallman.

These claims are all dependent from independent claim 1. Thus, Appellant believes that these claims are allowable in view of Appellant's discussion and the Examiner error with respect to the rejections discussed above. Accordingly, Appellant respectfully request that claims 4-12 be allowed by the Board.

8. SUMMARY

For the reasons argued above, claim 1 was not properly rejected under § 102(e) as being anticipated over Reese.

It is respectfully submitted that the art cited does not render the claim anticipated and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claims are respectfully requested.

Respectfully submitted,

MICHAEL J. WITZ et al.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402

Date 01/29/07

By / Joseph P. Mehrle /
Joseph P. Mehrle
Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of January 2007.

Name Peter Robuffoni

Signature

CLAIMS APPENDIX

1. A machine-implemented method comprising:

receiving over a wide-area network (WAN) an indication of a preference of a user from a first population of users that form a virtual community, wherein the first population of users is identified as investment analysts, and wherein the preference from the user is a selection of an investment or an allocation for the investment that the user provides to the virtual community;

aggregating the preference into a database of previously received preferences from the first population, the aggregation being a set of preferences; and

deriving a financial product for a second population of users in response to the set of preferences, the second population of users identified as investors.

2. The method of claim 1 wherein the financial product is a mutual fund.

3. The method of claim 1 further comprising:

associating with each preference a ranking of a submitting user; and

screening the preferences based on the ranking.

4. The method of claim 2 wherein deriving comprises:

identifying within the set of preferences a first subset of preferences having a capitalization and a trading volume consistent with predefined objectives of the mutual fund.

5. The method of claim 4 further comprising:

screening the first subset of preferences based on a ranking of a submitting user to create a second subset.

6. The method of claim 1 wherein each preference represents a stock in a model portfolio of a user, the method further comprising:

ranking the model portfolio relative to a population of model portfolios; and

providing rewards based on a reward structure to submitters of high performing model portfolios.

7. The method of Claim 2 further comprising:

receiving from an investor currency units to be invested in the mutual fund;

screening the set of preferences to identify a security to be added to the mutual fund; and

establishing a new position of the security in the mutual fund.

8. The method of Claim 2 further comprising:

receiving a request over the WAN for information about the mutual fund; and

serving a page reflecting current holdings of the mutual fund over the WAN.

9. The method of claim 1 wherein the financial product is a newsletter.

10. The method of claim 9 further comprising:

screening the set of preferences to generate a recommended list.

11. The method of claim 10 wherein the screening is based on at least one of:

ranking of a submitting user, investment style of the recommended list, capitalization, average trading volume, price to earning ratio, return on investment, gross margin, and revenue growth rate over a predetermined time period; and

generating analyst reports for submitting users satisfying predetermined criterion.

12. The method of claim 11 further comprising:

distributing the newsletter electronically; and

updating the analyst reports and recommendations with a frequency greater than weekly.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.